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In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 817

CECIL L. TANSEL, assignee of chose in action from Harris-Intertype Corporation,
PETITIONER,

v.

PHOTON, INC.,
RESPONDENT.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Blanchard Press, Inc., Boston, Mass. — Law Printers

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COUNTERSTATEMENT OF THE CASE

Petitioner's presentation of the case is characterized by some inaccuracies and some significant omissions. We first refer to a most important omission, which we believe is dispositive of the case.

The Only Issue Presented, Invalidity, Is Hypothetical Because The Judgment of Non-Infringement Stands Uncontested by Petitioner

Even if this Court should grant certiorari and should then decide that the petitioner was right in every contention presented by him, so that the patent* in suit would then be held valid, this could not result in a reversal in favor of the petitioner.

The District Court's findings on the issue of non-infringement are extremely thorough and involve a painstakingly complete analysis of the evidence before it. The findings appear at R. 563-569. On the basis of these findings the Court entered judgment "that use or sale by Photon or its customers of the photocomposing machines hitherto and now being manufactured by Photon constitute neither direct nor contributory infringement of . . ." the patents in suit (R. 571).

The judgment of the Court of Appeals affirms the judgments entered by the District Court (App. to Pet., page A-2). This is an affirmance *in toto* and hence an affirmance of the District Court's judgment of non-infringement as well as an affirmance of the judgment of invalidity.

The District Court's findings of non-infringement and the judgment in respect thereto are not in any way contested in the petition presented to this Court. Even if this Court should grant the petition, and if on full hearing it should reverse the decision of the Court of Appeals on the issue of validity, the judgment of non-infringement in Photon's favor would still stand.

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* There were two patents at issue below, both with the identical disclosure, but the petition seeks review only as to the later one.

The Decision of Invalidity of the Patents Follows From the Trial Court's Findings Based On Cogent Evidence Presented To the Court

Although we believe that the petitioner's tacit acceptance of the judgment of non-infringement is dispositive of the case, we turn to the facts bearing on the decisions of the courts below on invalidity, and endeavor to show that those decisions should not be disturbed.

The District Court held the patents invalid because there was ample evidence in the record to prove "that the substitution of strobe light for a shutter, is a normal development in the art, not involving invention". [Authorities]. . . (Opinion, R. 561), ". . . that all of the elements contained in the claims in issue . . . were old . . . and that the patents in suit call for nothing more than a combination of said old elements with no change in their respective functions" (Opinion, R. 563). The Court was "persuaded that defendant *has clearly shown** the absence of any new, novel, or unexpected results from this combination of old and known elements and procedures" (Opinion, R. 563).

The manner in which defendant (respondent here) clearly showed the absence of any novel or unexpected results was by actual evidence presented to the Court, including not only prior art cited by the Patent Office but also an important publication not cited by the Patent Office (Opinion, R. 560), together with extensive expert testimony by Dr. Gray in whose presentation the Court expressed great confidence (Opinion, R. 569). The testimony was amply supported by charts (e.g., Exhibits AM, AO, R. 404, 411, 1059, 1060) and by courtroom demonstrations (R. 395-399, 414-418, Ex. AQ, R. 418, 1063).

The great weight to be given findings of fact based on

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* Emphasis ours throughout.

the trial court's opportunity to judge the credibility of witnesses, especially "where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations" is recognized by this Court in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U.S. 271, 274 (1949).

Petitioner Misstates the Grounds on which the Courts Below Held the Patents Invalid.

On page 1 of his brief the petitioner says that the District Court "held both patents invalid primarily because certain mechanical switches used in the machine were held to be too inaccurate for commercial success". This was *not* the basis of the District Court's decision.

As noted above, the District Court held the patents invalid because they called for nothing more than a combination of old elements under the authority of *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corporation*, 340 U.S. 147 (1950) and other established cases, and also because there is no patentable invention in simply substituting one well-known device for another (i.e. strobe light for a shutter) in an old combination.

The District Court, after observing that defendant Photon had "clearly shown" the absence of any new or unexpected results, says (R. 563), "*Consequently,* I find both Tansel patents are invalid for lack of invention". Therefore, the holding of invalidity was in consequence of specific findings of fact bearing on unpatentability of old combinations and not because "certain mechanical switches used in the machine were held to be too inaccurate".

On page 2 the petitioner says that the Court of Appeals "affirmed *on a different ground*". The *per curiam* opinion of the Court of Appeals says that the Court is "satisfied" that the patents in suit call for nothing more than a com-

bination of elements shown to be old and producing no unexpected result; the opinion then says, "Accordingly, we *agree* with the conclusion of the District Court that both patents are invalid for lack of invention" (Appendix to petition, page A-2). Therefore, the Court of Appeals affirmed as to invalidity of the patents, not on a *different* ground, but actually on the *same* grounds as the decision of the District Court.

Notwithstanding Petitioner's Argument About The Importance of His Invention, His Assignee Never Attained Any Success With It.

Throughout his brief, the petitioner harps upon the alleged "importance" of the invention of the patents in suit. The petitioner, however, significantly omits any reference to the most relevant fact, namely, that his assignee accomplished nothing at all commercially with the invention over a long period of years.

The patents in suit were actually owned for many years by Harris-Intertype Corporation as assignee of Tansel. Harris-Intertype was the plaintiff in the suit against Photon. Harris-Intertype is one of the largest manufacturers of offset printing machines. Furthermore, its Intertype division manufactures conventional lead casting composing equipment (R. 125), and it manufactures the so-called "Fotosetter", a *photographic* composing machine which does not utilize the features of the Tansel patents (R. 142, 173-177).

At the time of the trial Harris-Intertype Corporation had not sold a single machine of the patented type. The District Court made the significant finding that "despite the lapse of time since the filing of the Tansel application in 1945, almost twenty years ago, no machines have been

successfully marketed on the basis of the Tansel disclosures" (Opinion, R. 562).

Whether the commercial failure of the plaintiff was due to ineptitude or to an unwillingness to compete with its non-infringing Intertype and Fotosetter machines, the fact remains that Tansel's assignee accomplished nothing with an invention which the petitioner touts as "important".

The petitioner's case on importance of the invention seems to ride on certain literature emanating from the defendant, copies of which are reproduced at pages 19-28 of petitioner's brief. The District Court did not ignore this material as petitioner contends (Question 3) but rather took due note of it and found that "the evidence offered at the trial indicates that . . . the statements are grossly over-optimistic" and that "the trade has not opened either its arms or its pocketbook to welcome these newcomers" (Opinion, R. 562).

ARGUMENT

The Petitioner's Attempt To Manufacture A Conflict of Decisions Comes To Naught

Although we believe that the facts set forth in the foregoing counterstatement suffice to dispose of the case notwithstanding the petitioner's contentions, we address ourselves briefly to what appears to be petitioner's principal argument, namely, his contention that there is a diversity of opinion between the decision of the Court of Appeals in this case and the Court of Customs and Patent Appeals. The decision of the Court of Customs and Patent Appeals, printed in the Appendix to the petition at A-6 to A-20, was a decision in an interference proceeding, in which the only issue before the Court was *priority of in-*

vention. The sole issue was whether Tansel was the prior inventor or Higonnet and Moyroud were the prior inventors of the subject matter of two claims involved in the interference.

No issue of the patentability or validity was in any way involved in the case before the Court of Customs and Patent Appeals. The sole issue was: *assuming* the claims to be patentable, who was the first inventor thereof? Thus in *Wirkler* v. *Perkins et al*, 245 F.2d 502 (CCPA 1957):

> . . . It is well settled that issues of patentability will not be considered by this court in an interference since patentability is not a question ancillary to priority. This is such a well known rule as to require no citation of authority.

It is on jurisdictional grounds that the Court of Customs and Patent Appeals bases its inability to consider questions of patentability in an interference, since the statute (35 U.S. Code 141) provides, "A party to an interference dissatisfied with the decision of the board of patent interferences *on the question of priority* may appeal to the United States Court of Customs and Patent Appeals . . ." *Glass* v. *DeRoo et al*, 239 F.2d 402 (CCPA, 1956).

There is a long history of uniform application of this rule, not only in the Court of Customs and Patent Appeals but also in the Court of Appeals of the District of Columbia, which was its predecessor court in appeals from the Patent Office. The *Glass* case cites some twelve earlier cases in both courts, at least one as early as 1906. Thus the line of authority that *only* the question of priority will be considered extends from a long time prior to the CCPA decision in the *Tansel* v. *Higonnet et al* interference to the present time.

The CCPA did not depart from this rule in the *Tansel* interference and there was no reason for it to do so.*

The *decision* of the CCPA in the interference was a decision of priority, and the evidence before that Court was concerned with the dates on which the parties performed certain acts. The *decision* of the courts below in this suit is concerned with the patentability of patent claims. The evidence on which the trial court rendered its decision of invalidity comprises the prior art, the testimony of the expert witness, and the courtroom demonstrations referred to on page 3 *supra,* none of which was before the CCPA in the interference; indeed none of that evidence could have been considered by the CCPA.

Therefore, the two courts which the petitioner contends are in conflict tried different issues on different evidence. There is no possible conflict of *decisions* on the *same matter* (Rule 19 (b) of this Court).

SUMMARY AND CONCLUSION

The petitioner presents a purely hypothetical case, and the grant of certiorari by this Court would be a useless proceeding, since even if the petitioner should prevail on the arguments presented by him, the judgment of non-infringement would still remain in effect and the action against Photon would stand dismissed.

The decisions of the courts below as to invalidity are firmly grounded on extensive findings of fact made on the basis of the actual evidence. The petitioner seeks a

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*The petitioner fastens on to a statement made in the second paragraph of the CCPA opinion to the effect that the invention was "regarded as a fundamental advance in the printing art" (Question 2, pages 3, 14 of petition). In so far as the petitioner uses this in an effort to impute patentability, it is a purely gratuitous statement which is outside the bounds of justiciable subject matter of the CCPA.

review of the facts under the guise of a "conflict". No such conflict exists.

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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